



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,123	08/16/2001	Gary S. Foster	01985-P0040C	3575

24126 7590 10/09/2003

ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD, CT 06905-5619

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/931,123

Applicant(s)
Foster et al

Examiner
Daniel Felten

Art Unit
3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 16, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

Serial Number: 09/931,123

Applicant(s): Edelstein et al. (705/37)

Page 2

Art Unit: 3624

Representative: Whitmyer, Jr. (33,558)

DETAILED ACTION

1
2 1. It is acknowledged that the presented application is a Continuation-In-Part of US Patent
3 Application No. 09/504,803 filed February 16, 2000. Claims 1-28 are pending in the
4 application and are presented to be examined upon their merits.

5
6 2. Prior art cited in Applicant's the Information Disclosure Statement has been considered
7 and is acknowledged.

Claim Rejections - 35 USC § 112

8
9
10
11
12 3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

13 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
14 the subject matter which the applicant regards as his invention.

15
16 4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite
17 for failing to particularly point out and distinctly claim the subject matter which applicant
18 regards as the invention. The aforementioned claims recite, "a system...". it is unclear

1 whether the examiner is claim an apparatus or a method in the claims. However, for
2 examination purposes only, the examiner interrupts the claims to recite an apparatus.

3
4 ***Claim Rejections - 35 USC § 103***

5
6 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
7 obviousness rejections set forth in this Office action:

8 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
9 in section 102 of this title, if the differences between the subject matter sought to be patented and the prior
10 art are such that the subject matter as a whole would have been obvious at the time the invention was
11 made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall
12 not be negated by the manner in which the invention was made.
13

14 6. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson
15 (US 4,823,265) in view of Moy (US 4,823, 265).

16
17 Nelson discloses, as in claims 1, 10, 15 and 24, an apparatus and method for facilitating
18 the processing and management of a securities trade comprising:

19 A computer (see Nelson, figs. 1& 2, col. 3, ll. 4-19);

20 as also in claims 2, 5, 8, 9, 11-14, 25-28 trade execution information received by the
21 computer, the trade execution information indicative of an executed trade *supplied by a first*
22 *trading party*, and comprises software executed on the computer (see Nelson, col. 1, ll. 60-66),

1 and comprising party supplied data elements *concerning the conditions of the* ordered trade itself
2 (see Nelson, col. 1, ll. 60-66; col. 4, ll. 21+);

3 as also in claims 3, 4, 6, 7, 17, 18 trade allocation information received by the computer,
4 the trade allocation information indicative of an ordered trade by a second trading party (*seller*)
5 and comprising trade data concerning one or more details of the ordered trade itself (see Nelson,
6 col. 3 , ll. 7+);

7 a set of predefined acceptable trade parameters/profiles (see Nelson, figs. 4a-d, col. 3, ll.
8 5+; col. 4, ll. 21+); and

9 software for determining that a match exists if the trade data contained in execution
10 information and the *party supplied data elements* correlate within the set of predefined
11 acceptable trade parameters (see Nelson, col. 1, ll. 48-55; and col. 9, ll. 29-41; and col. 15, ll.
12 41+).

13 Nelson fails to disclose the limitation, as in claim 15, of software executing on the
14 computer for determining block level trade execution information based upon the trade execution
15 information and comparing the block level information with the block trade level order
16 information.

17 Moy discloses a data processing program with a market monitoring service which uses a
18 block trade ticker (bt) to identify all trades exceeding ten thousand shares (see col. 5, ll. 64 to col.
19 6, ll. 37).

It would have been obvious for an artisan at the time of the invention to integrate the monitor marketing software using the block trade ticker, as disclosed by Moy into the invention of Nelson because an artisan at the time of the invention would have recognized that the integration of aforementioned software to create a broader investment market for individual investors as well as provided a generalized view of the current market being traded. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

Conclusion

7. A list of relevant prior art appears below not relied upon in this Office Action:
US Patent:

Adams (US 3,573,747) discloses an Instinet communications Block Trading system

Hammons et al (US 6,477,509) discloses Internet Marketing Method and system

Joao et al (US 5,878,337) discloses transaction security apparatus and method

Longfield (US 5,724,523) discloses electronic income tax refund system utilizing tax refund.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

9. Response to this action should be mailed to:
Commissioner of Patents and Trademarks

1 Washington, D.C. 20231

2 for formal communications intended for entry, or (703) 305-0040, for informal or draft
3 communications, please label "Proposed" or "Draft".

4 Communications via Internet e-mail regarding this application, other than those under 35
5 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
6 addressed to [daniel.felten@uspto.gov].

7 All Internet e-mail communications will be made of record in the application file. PTO
8 employees do not engage in Internet communications where there exists a possibility that
9 sensitive information could be identified or exchanged unless the record includes a properly
10 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
11 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
12 Trademark on February 25, 1997 at 1 195 OG 89.

13 

14
15 **DSF**
16 **September 30, 2003**



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600